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09/555,590	07/21/2000	HENRY WYNDHAM WODEHOUSE	228-009468US	1150

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,590

Applicant(s)

WODEHOUSE ET AL.

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 15-21, 23-25, and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. for example, claim 1 line 8; claim 2 line 6, etc. In particular, claims 1-3; 15, 21, 23-24 and 36, the phrase "and/or" renders the claims indefinite because, it is unclear whether the limitations following the phrase are part of the claimed invention. For purpose of examination only, Examiner assumes that the claim limitation is "or".

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20, 39-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts. The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, a non-descriptive material per se. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is

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not a product for performing a process, nor is it a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1-20, 39-47 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform the underlying process. Claims 1-20, 39-47 do not appear to correspond to a specific machine or manufacture, and thus encompass any product of the class configured in any manner to perform the underlying process. The claimed invention of claims 1-20, 39-47 also do not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 1-20, 39-47 are analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

See *State Street Bank & Trust Co. V. Signature Financial Group Inc.*, 47 USPQ2d 1597 (Fed. Cir. 1998) where the Federal Circuit held that: "[T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it provides "a useful, concrete and tangible result".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-11, 13, 20-31, 36-38 & 44-47 rejected under 35 U.S.C. 102(e) as being anticipated by Marcous et al (hereinafter Marcous – US 5,650,604).

Re. Claim 1, Marcous discloses a fully automated electronic transfer system [see entire document particularly, Abs; Fig. 1-4; C1 L5 to C3 L37], receiving at the processing means a money transfer request from the input device, and providing within the processing means a first identifier code for the transfer or for at least one of the parties to the transfer, and sending the first identifier code directly or indirectly to the transferor if the first identifier code (unique DES-encrypted PIN) is a new code (PIN), the sending operation to the transferor being an independent operation from the communication with the input device, and outputting money transfer instructions including at least a portion of the first identifier code or information related thereto, and communicating the money transfer instructions to a money handling authority as instructions to effect the money transfer, whereby the authority of the transferee party to receive the funds can be verified upon presentation of the first identifier code by the transferee party [Abs; Fig. 3-4; C2 L23; C3 L40 to C4 L30; C4 L65 to C5 L16-L35; C6 L21-L55; C8 L11-L67].

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Re. Claim 5, Marcous discloses wherein the step of providing the first identifier code comprises selectively allocating a new identifier code (PIN) [C6 L33].

Re. Claim 6, Marcous discloses wherein the party identifier code is associated with the transferor (security code) [C5 L25-L36].

Re. Claim 7, Marcous discloses wherein the processing means comprises a database of transferors, the database containing for each transferor the or a party identification code associated therewith [Fig. 1; C7 L17-L41; C9 L24-L30].

Re. Claims 9-10, Marcous discloses further comprising generating a second identifier code associated with the transaction, and outputting the second identifier code to the transferor, and wherein the step of generating the money transfer instructions at the processing means comprises including a verification code related to the second identifier code to enable the correct second identification code (security code) to be verified when presented by the transferee, and wherein the second identifier code is outputted to the transferor at the or a remote terminal (ATM) [C5 L16-L35; C11 L58-L65].

Re. Claim 20, Marcous discloses storing the or each identifier code at the processing means [Abs; C2 L52-L67].

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Re. Claims 2 and 23, Marcous discloses a fully automated electronic transfer system [see entire document particularly, Abs; Fig. 1-4; C1 L5 to C3 L37], and receiving at the processing means information representing a money transfer request, and providing within the processing means a first identifier code associated with the transfer or with at least one or the parties to the transfer, and sending the first identifier code directly or indirectly to the transferor if the first identifier code is a new code (PIN), and outputting money transfer instructions including at least a portion of the first identifier code or information related thereto; and communicating the money transfer instructions to a money handling authority as instructions to effect the money transfer, whereby the authority of the transferee party to receive the funds can be verified upon presentation of the first identifier code by the transferee party [see claim 1 above].

Re. Claims 3-4, 24-25 Marcous discloses a fully automated electronic transfer system [see entire document particularly, Abs; Fig. 1-4; C1 L5 to C3 L37], and receiving transfer instruction information directly or indirectly from the transferor, and providing a first identifier code associated with the transfer or with at least one of the parties to the transfer, the code being required by the transferee to complete the money transfer operation, and outputting or selectively outputting the first identifier code for communication to the transferor, wherein in step the first identifier code is outputted for confidential communication (encrypted communication) to the transferor independently of the communication in step (a) [see claim 1 above], and wherein step (c) comprises

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selectively outputting the first identifier code if the code is newly allocated (generated) [C11 L13-L6].

Re. Claim 11, Marcous discloses a fully automated electronic transfer system [see entire document particularly, Abs; Fig. 1-4; C1 L5 to C3 L37], and generating an identifier code associated with a transfer request, and outputting the identifier code for communication to the transferor, and outputting from the processing means money transfer instructions including a verification code related verifiably to the identifier code, and communicating the money transfer instructions to a money handling authority as instructions to effect the money transfer, whereby the authority of the transferee party to receive the funds can be verified at least partly upon presentation of the original identifier code matching the incomplete code (any entry) in the money transfer instructions [see claim 1 above; C2 L52 to C3 L3].

Re. Claim 13, Marcous discloses wherein the money transfer request is generated at a terminal remote (ATM) from the processing means, and the identifier code is outputted at the terminal for the transferor [C5 L16-L35; C11 L58-L65].

Re. Claim 21, Marcous discloses at least one input unit operable to generate a money transfer request in accordance with information from a transferor, and processing means for communicating with the or each input unit for receiving and processing money transfer requests therefrom, the processing means comprising: means for

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providing a first identifier code for the transaction or for the one or more parties to the transfer, and means operable to output first information including the first identifier code, to be communicated directly or indirectly to the transferor independently of the communication operation with the input unit, and means for outputting money transfer instructions including at least a portion of the first identifier code or information related thereto, for communication to a money and handling authority as instructions to effect the money transfer, whereby the authority of a transferee party to receive the funds can be verified at least partly by presentation of the first identifier code by the transferee party [see claim 1 above].

Re. Claim 22, Marcous discloses comprising at least one remote input unit (ATM) [Figures 1-2; C3 L60].

Re. Claim 26, Marcous discloses wherein the means for providing the first identifier code comprises means for selectively allocating a new identifier code, or re-using a previously allocated identifier code (PIN) [C6 L33].

Re. Claim 27, Marcous discloses wherein the first identifier code comprises a party identification code associated with the transferor (security code) [C5 L25-L36].

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Re. Claim 28, Marcous discloses wherein the processing means comprises a database of transferors, the database containing for each transferor the or a party identification code allocated thereto [Fig. 1; C7 L17-L41; C9 L24-L30].

Re. Claim 29, Marcous discloses wherein the means for allocating a new first identifier code comprises means for generating a code based on a random or pseudo random code (random number) [C11 L13-L6] .

Re. Claims 30-31, Marcous discloses further comprising means for generating a second identifier code associated with the transaction, and outputting the second identifier code to the transferor, and wherein the means for generating the money transfer instructions at the processing means comprises means for including a verification code related to the second identifier code to enable the correct identifier code to be verified when presented by a transferee, and wherein the second identifier code is outputted to the transferor at the or a remote terminal (ATM) [C5 L16-L35; C11 L58-L65].

Re. Claim 36, Marcous discloses input means for receiving information regarding the transfer and the parties to the transfer, and means operable to allocate or to receive a transaction identifier code, and means for outputting the transaction identifier code for communication to the transferor, and means for storing information relating to the requested money transfer, said information including the allocated identifier code (PIN),

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and means for communicating with a said central processor (# 115) [see claim 1 above; Fig. 1; C6 L33]

Re. Claim 37-38, Marcous discloses wherein the input device comprises a card reader for reading information on a card presented thereto [C11 L31-L34]. However, Marcous, explicitly, does not disclose wherein the card reader comprises a magnetic card reader, but, this is prior art and well known where credit cards have a magnetic strips which holds card information particularly the card number which allows card read to read the card number.

Re. Claim 44, Marcous discloses receiving transfer instructions including a first party identifier code allocated to at least one of the parties to the transfer, and a second transaction verification code related to a transaction identifier code allocated to the transaction, and comparing the first party identifier code from the transfer instructions with a party identifier code provided by the transferee, and comparing the second transaction verification code with a transaction identification code provided by the transferee [see claim 1 above].

Re. Claim 45, Marcous discloses returning the transaction identification code to the issuing authority as evidence that the transferee is authorized to receive the funds [C6 L15-L49].

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Re. Claims 46-47, Marcous discloses wherein the transaction verification code contains some, but not all of the characters of the transaction identification code, and the method comprises comparing each known character in the transaction verification code for equivalency with a corresponding character of the transaction identifier code, and wherein the transaction verification code includes information associated with the result of a function based on one or more characters of the transaction identification code, and the method comprises testing whether the transaction identification code presented by the transferee matches the function [C5 L52-L67; C6 L15-L49; C8 L53-L67].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous.

Re. Claims 8 & 12, Marcous discloses generating said unique personal identification number (random number) [C11 L13-L6]. Further, random number generator is well known.

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Claims 15-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous as applied to claim 11 above, in view of Tedesco et al (hereinafter Tedesco - US 6,282,523).

Re. Claim 15, Marcous discloses generating a code, and wherein the characters in the identifier code are numeric. Marcous, explicitly, does not disclose wherein the identifier code is generated such that at least one character thereof represents a function of one or more other characters of the identifier code, and the step of providing the verification code comprises generating a code comprising at least one, but not all, of the characters of the identifier code and including information indicative of the position in said identifier code of said at least one character or of said one or more other characters. However, Tedesco discloses this step [Abs; Figures 1-11C; C1 L5 to C3 L46; C5 L56 to C7 L65]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine teaching of Marcous and Tedesco and include characters of the identifier code to provide easy access code and a encrypted code that indicates valid data.

Re. Claims 16-19, Marcous, explicitly, does not disclose wherein the function is a sum function, wherein the verification code comprises one or more blank characters representing missing character or digit positions of the identifier code, and wherein the function is based on characters in one or more predetermined positions in the identifier code, and said information represents the position in said identification code of the

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result of the function. However, these steps are commonly known and used in computer coding of data integrity using encryption for data transfer where data is added with checksum (CRC).

Claims 14, 32-34, 35, 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous in view of Atalla et al (hereinafter Atalla – US 5,319,710).

Re. Claims 14, 32, 35 and 39, Marcous discloses a fully automated electronic transfer system [see entire document particularly, Abs; Fig. 1-4; C1 L5 to C3 L37], and receiving at the processing means information representing a money transfer request, and providing an identifier code, and outputting from the processing means money transfer instructions including the transaction verification code, for communication to a money handling authority as instructions to effect the money transfer, whereby the authority of the transferee party to receive funds can be verified at least partly upon presentation of the original identifier code matching the verification code in the money transfer instructions. Marcous, explicitly, does not disclose providing a verification code related verifiably to the identifier code, the verification code being insufficient to enable the identifier code to be deduced unambiguously therefrom. However, Atalla discloses this step [see entire document particularly, Abs; figures 1-2C; C1 L15 to C2 L35; C3 L60 to C4 L27]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine teaching of Marcous and Atalla to provide verification code (ACK/NACK) to reduce additional operational overhead.

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Re. Claims 33-34, Marcous discloses wherein the identifier code is generated as, or is based on, a random or pseudo random code (random number) [C11 L13-L6], and wherein the input device is a remote terminal (ATM) [Figures 1-2]. Further, random number generator is well known.

Re. Claims 40-43, Marcous discloses wherein the step of communicating information to the transferor comprises selectively communicating the party identifier code [C6 L21-L55], and wherein the step of communicating information to the transferor comprises communicating the party identifier code if the party identifier code is newly allocated [C6 L21-L55], and wherein the step of communicating information to the transferor comprises not communicating the party identifier code if a party identification code has previously been allocated for an earlier transaction between the same parties, and is to be re-used for the current transaction [C6 L33], and wherein the party identification code, if communicated to the transferor, is communicated independently of the transaction identifier code [see claim 1 above].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

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US Pat. 5,920,629 to Rosen, July 6, 1999 "Electronic-monetary system", this invention discloses an electronic monetary system for implementing electronic money transactions as an alternative medium of economic exchange to cash, checks, credit and debit cards, and electronic funds transfer.

US Pat. 5,428,684 to Akiyama et al, June 27, 1995 "Electronic cashless transaction system", this invention discloses a security enhancement for an electronic cashless transaction system comprising elements such as a bank center, a bank ATM, an IC card and a store transaction terminal [e.g. a modified POS.

US Pat. 4,630,201 to White, Dec. 16, 1986 "On-line and off-line transaction security system using a code generated from a transaction parameter and a random number", this invention discloses system and method for improving security in a funds transfer environment. The security system is suitable for both on-line and off-line operation and is particularly adapted to promote security in an off-line check-writing situation.

US Pat. 5,659,165 to Jennings, Aug. 19, 1997 "Customer-directed, automated process for transferring funds between accounts via a communications network", this invention discloses a system and method for allowing funds to be transferred instantly to an account so that the funds are available to the beneficiary at the time they are sent, based on customer information which can be automatically accessed by the system, rather than needing to be manually entered. Further, the system automatically

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computes the appropriate exchange rate and any fees to be charged to the account and displays them to the user so that the user may authorize or cancel the transaction. The system also analyzes the parameters of the transfer to assure that the transfer conforms with pertinent government regulations.

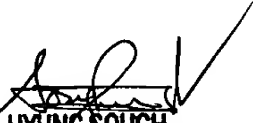
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Harish T Dass HTD
Examiner
Art Unit 3628

11/20/03


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600